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| EXAMINER |
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COURSON, TANIA C

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2859

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Please find below and/or attached an Office communication concerning this application or proceeding.



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GROUP 2800

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/068,078
Filing Date: February 05, 2002
Appellant(s): JUDGE, DANIEL M.

Charles Hieken
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 26, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 3, 5-7, 15-18, 20-21 and 23-28 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

| | | |
|-----------|-------------------|---------|
| 6,282,807 | Johnson | 09-2001 |
| 4,195,787 | Thomason | 04-1980 |
| 4,076,121 | Clayton et al. | 02-1978 |
| 6,221,211 | Hollenberg et al. | 04-2001 |
| 5,266,257 | Kildune | 11-1993 |

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

A) Claims 3 and 5-7 are finally rejected under 35 U.S.C. 102(b) as being unpatentable by USPN 4,195,787 to Thomason.

Numerals A and B have been added to Figure 2 and numeral C has been added to Figure 6 in reference to certain components of the rolled product disclosed by Thomason. See copy attached at the end of this action.

Thomason discloses a rolled product of continuous separable sheets, comprising at least a first (A) and second (B) contiguous separable sheet of product wound around an axis (C), forming a cylindrical roll, each sheet having an outer edge positioned parallel to the axis; at least the first and second contiguous separable sheet (A, B) of product (11) having at least one indicium (14) that bears a predetermined relationship when the first sheet is the outer most sheet of the rolled product (11), such that a discontinuity of the indicium is likely to be formed between the outer edge of each sheet having the indicium and the portion of the indicium which

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lies directly beneath the outer edge of each sheet having the indicium when the sheets are formed into a cylindrical roll, wherein the indicium is a continuous undulating indicium (14', see Figure 4) (column 1, lines 22-23); at least the first and second sheet of contiguous separable sheet (A, B) of product (11) have a plurality of indicium (14, D); the plurality of indicium are out-of-phase from each other; the continuous undulating indicium are sinusoid-shaped (See Figure 4) having a predetermined wavelength.

B) Claims 15-18, 20-21, 23-24 and 26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,282,807 to Johnson in view of Thomason.

Johnson discloses a rolled product wherein normal manufacture of the product comprises the method steps of making a roll of product with a mark for visually locating the end of the roll comprising marking the sheets with at least one visually perceivable mark extending the length continuously for the entire length of said roll, the visually perceivable mark bearing a predetermined relationship between the portion of the mark at the edge of the roll and the portion of the mark that lies directly beneath each edge when the product is spooled onto a roll, such that a discontinuity is likely formed between the mark at any edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located and spooling the product into a cylindrical roll; the indicium is printed on the sheets (column 6, lines 21-23).

Johnson does not disclose the rolled product to be a roll of contiguous separable sheets of product; marking the sheets with a plurality of marks; the plurality of marks being sinusoid-shaped; the sinusoid-shaped marks are out of phase from one another; the sheets being toilet

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paper; the sheets being paper toweling.

With respect to claims 15, 20-21, 23-24, and 26: Thomason discloses the rolled product, such as toilet paper (column 1, paragraph 1) and/or paper toweling (column 1, paragraph 1) as described above in paragraph A wherein normal manufacture of the device comprises the method steps of making a roll of contiguous separable sheets of product with a mark for visually locating the end of the roll comprising marking the sheets with at least one visually perceivable mark extending the length of each of the sheets, the visually perceivable mark bearing a predetermined relationship between the portion of the mark at the edge of each sheet and the portion of the mark that lies directly beneath each edge when the sheets are spooled onto a roll, such that a discontinuity is likely formed between the mark at any sheet edge and the portion of the mark which lies directly beneath the edge on the roll, thereby allowing the end of the rolled product to be visually located and spooling the sheets into a cylindrical roll. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add perforations to the rolled product, disclosed by Johnson, to replace the serrated edge so the rolled product will be made of separable sheets, as taught by Thomason, in order for the rolled product to be more convenient for the user because they more easily tear off only as much product as needed without the risk of cutting themselves on the serrated edge or blade.

With respect to claims 16-18: Thomason discloses the rolled product as described above in paragraph A wherein normal manufacture of the device comprises the method steps of marking the sheets with a plurality of marks and the plurality of marks are each sinusoid-shaped and out of phase with one another (see Figure 4). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use sinusoid-shaped

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marks which are out of phase with one another, as taught by Thomason, instead of the mark, disclosed by Johnson, in order for the product to be more visually appealing while ensuring that a user will be able to see the indicating mark.

C) Claim 25 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and Thomason as applied to claims 15-18, 20-21, 23-24 and 26 above, and further in view of USPN 4,076,121 to Clayton et al. [hereinafter Clayton].

Johnson and Thomason disclose the rolled product of contiguous separable sheets as described above in paragraph B.

Johnson and Thomason do not disclose the rolled product wherein the sheets are plastic bags.

Clayton discloses a rolled product being separable sheets of plastic bags. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the indicia disclosed by Johnson and Thomason with a rolled product comprised of separable sheets of plastic bags, as taught by Clayton, in order to determine the free end of the rolled product and since Johnson and Thomason already suggests that the indicia could be used with products manufactured in a rolled form (Thomason, column 1, lines 1- 10).

D) Claim 27 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and Thomason as applied to claims 15-18, 20-21, 23-24 and 26 above, and further in view of USPN 6,221,211 to Hollenberg et al. [hereinafter Hollenberg].

Johnson and Thomason discloses a rolled product of contiguous separable sheets as

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described above in paragraph B.

Johnson and Thomason do not disclose the rolled product wherein the mark is dyed on the sheets.

Hollenberg discloses a tissue product having a mark that is dyed on the sheets (17). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the indicia dyed on the sheets, as taught by Hollenberg, instead of imprinted, as taught by Johnson and Thomason, since the way that the indicia is added to the rolled product is considered to be nothing more than the use of one of numerous and well known alternate types of methods for adding marks that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to permanently add the indicia on the rolled product.

E) Claim 28 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson and Thomason as applied to claims 15-18, 20-21, 23-24 and 26 above, and further in view of USPN 5,266,257 to Kildune.

Johnson and Thomason discloses a rolled product of contiguous separable sheets as described above in paragraph B.

Johnson and Thomason do not disclose the rolled product wherein the indicia is embossed on the sheets.

Kildune discloses a rolled product having indicia (12) embossed onto the product. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the indicia embossed on the sheets, as taught by Kildune, instead of

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imprinted, as taught by Johnson and Thomason since the way that the indicia is added to the rolled product is considered to be nothing more than the use of one of numerous and well known alternate types of methods for adding marks that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to permanently add the indicia on the rolled product.

(11) *Response to Argument*

Group I. Thomason 102 (b) - Claims 3 and 5-7

- a) Appellant's comment regarding the request for the Examiner to quote verbatim the language in the reference has been considered and to the extent possible the Examiner has clearly pointed out by reference to column and line numbers, the location in the references where the features used by the Examiner are described. See prior office action (mailed March 19, 2004).
- b) Appellant's comment regarding the lack of a continuous undulating indicium extending continuously along the length of each of the sheet continuously **for the length of the entire roll** in Thomason is not persuasive because claims 3 and 5-7 positively claim only a first and second contiguous separable sheet of product.

Group II. Johnson in view of Thomason 103 (a) - Claims 15-18, 20-21, 23-24 and 26

- a) Appellant's comment regarding the lack of suggestion in Thomason for a visually perceptible mark extending the length continuously for the entire length of said roll is not persuasive because Thomason is the secondary reference used to show that it is already known in the art

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to have contiguous separable sheets of product. It is Johnson, as the primary reference, who teaches a visually perceptible mark extending the length continuously for the **entire length** of said roll.

- b) Once again, appellant's comment regarding the request for the Examiner to quote verbatim the language in the reference has been considered and to the extent possible the Examiner has clearly pointed out by reference to column and line numbers, the location in the references where the features used by the Examiner are described. See prior office action (mailed March 19, 2004).
- c) Appellant's argument that the references cannot be combined is not persuasive because the Appellant has not stated the reasons why the references cannot be combined.

Group III. Johnson and Thomason further in view of Clayton et al. 103 (a) – Claim 25

(The Appellant states this argument as Group IV when it should be stated as Group III, the Examiner has renumbered the arguments to be numerically consistent).

- a) Once again, appellant's comment regarding the request for the Examiner to quote verbatim the language in the reference has been considered and to the extent possible the Examiner has clearly pointed out by reference to column and line numbers, the location in the references where the features used by the Examiner are described. See prior office action (mailed March 19, 2004).
- b) In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

- c) Appellant's argument that the references cannot be combined is not persuasive because the Appellant has not stated the reasons why the references cannot be combined.

Group IV. Johnson and Thomason further in view of Hollenberg et al. 103 (a) – Claim 27

- a) Appellant's comment regarding the lack of suggestion in Thomason for a visually perceptible mark extending the length continuously for the entire length of said roll is not persuasive because Thomason is the secondary reference used to show that it is already known in the art to have contiguous separable sheets of product. It is Johnson, as the primary reference, who teaches a visually perceptible mark extending the length continuously for the **entire length** of said roll.
- b) Once again, appellant's comment regarding the request for the Examiner to quote verbatim the language in the reference has been considered and to the extent possible the Examiner has clearly pointed out by reference to column and line numbers, the location in the references where the features used by the Examiner are described. See prior office action (mailed March 19, 2004).

Group V. Johnson and Thomason further in view of Kildune 103 (a) – Claim 28

- a) Appellant's comment regarding the lack of suggestion in Thomason for a visually perceptible mark extending the length continuously for the entire length of said roll is not persuasive because Thomason is the secondary reference used to show that it is already known in the art

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to have contiguous separable sheets of product. It is Johnson, as the primary reference, who teaches a visually perceptible mark extending the length continuously for the **entire length** of said roll.


- b) Once again, appellant's comment regarding the request for the Examiner to quote verbatim the language in the reference has been considered and to the extent possible the Examiner has clearly pointed out by reference to column and line numbers, the location in the references where the features used by the Examiner are described. See prior office action (mailed March 19, 2004).


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

tcc
November 22, 2004

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